

REMARKS

Claims 1-12 are pending. Claims 1, 2, 6, 7 and 9 are the only independent claims.

Applicants thank the Examiner for the indication that claims 2, 3 and 6 are allowed.

Claims 1, 4, 5, 7, 9 and 12 were rejected under 35 U.S.C. § 103 as obvious from U.S. Patent 6,104,714 (Baudelot). Applicants traverse and submit that independent claims 1, 7 and 9 are patentable for at least the following reasons.

Claim 1 is directed to a broadcasting control system in an ATM ring network in which a control cell containing control information is transmitted by ATM (Asynchronous Transfer Mode) between a plurality of nodes connected into a ring shape. Each of the nodes includes: receiving means for receiving a control cell from an upstream node, and transmitting means for writing response information of the self node for the control information contained in the received control cell in an area corresponding to the self node in the control cell and transmitting the control cell to a downstream node.

In claim 1, the transmitting means of a node writes response information of the self node for the control information contained in the received control cell in an area corresponding to the self node in the control cell and transmits the control cell to a downstream node. As discussed in the specification with reference to Figure 1, a control user cell A1 sent from the node 1-1 is input to the node 1-2 through the downstream transmission line 102. The node 1-2 *rewrites a data portion related to itself in the received cell A1 to response data* and sends a rewritten cell A2 to the downstream node 1-3. Of course, the invention is not limited to the disclosed embodiments.

To establish a *prima facie* case of obviousness requires that each and every feature in the claim be taught or suggested in the prior art. The most recent Office Action again

conceded that Baudelot does not contain any teaching of the above-mentioned feature. Moreover, the Examiner did not provide an example of any other art which actually teaches or remotely suggests the feature of claim 1 discussed above. For at least this reason, the Examiner has failed to show that the prior art taught or suggested *each and every feature* of the claim.

Rather than identify a secondary reference that exhibited the missing feature, the Office Action attempted to explain why it would have been obvious to change the way Baudelot works to make it work as recited in the claim. That is, the position was taken that it would have been obvious to “replace the arrangement of information writing in the control cell with the arrangement in the data cell disclosed by Baudelot so that the cell can be used to write information for many nodes to utilize bandwidth of a ring more efficient[ly].” It is presumed that what is meant by this statement is that the Examiner believes it would have been obvious to redesign Baudelot, despite the absence in the prior art of any secondary reference to suggest such a redesign, so that Baudelot’s information of different stations is in the control cell, instead of in the data cell, which is where Baudelot locates that information.

First, even if for some reason one would have followed the Examiner’s proposal and taken the information from Baudelot’s data cell and transferred it to Baudelot’s control cell, the *apparatus thus modified would still not meet the features of the claim*. Simply having information of different stations in the control cell of Baudelot would not meet the feature of claim 1 that the transmitting means of a node *writes response information of the self node* for the control information contained in the received control cell *in an area corresponding to the self node* in the control cell.

In claim 1, it is not just any information that written in the control cell, nor is it written in just any place in the control cell. In order for the proposed modification to have met the claim limitations, the proposed transfer of what Baudelot writes in the data cell to the

control cell would: (a) have to be information of the self node; and (b) have to be written in an area corresponding to the self node in the control cell. The Office Action does not even allege that such a modification of Baudelot would actually meet these claim limitations, and therefore fails to establish a *prima facie* case of obviousness for this additional reason.

Further, in spite of the fact that this deficiency was pointed out in the previous response, the “Response to Arguments” section of the Office Action completely ignores it. As can be seen by the foregoing, even the proposed modifications to Baudelot would not result in a device that meets all the claim limitations of claim 1.

If the Examiner maintains this rejection, it is requested that he prepare an affidavit attesting to the fact that somehow the information in Baudelot’s data cell, which the Examiner proposed to transfer to the control cell, actually includes *information of the self node* for the control information contained in the received control cell *in an area corresponding to the self node* in the control cell. Absent such a showing, *even the proposed modification* (which is itself improper for other reasons discussed below) of Baudelot cannot meet the features of claim 1. It is completely improper to fail to give patentable weight to even one word of the claim. In this case, the Examiner has ignored, and therefore failed to give patentable weight to, at least the limitation of claim 1 discussed above. For at least the reasons set forth above, the Office Action did not set forth a *prima facie* case of obviousness as against claim 1.

Further, although the above deficiencies of the Office Action are enough to make the rejection untenable, the Office Action also completely fails to provide any motivation as to why one of ordinary skill in the art would actually modify Baudelot in the first place. For any proposed modification of a prior art reference, the Examiner must provide a motivation, found in the prior art, that would have caused a person of ordinary skill in the art to make the proposed modification. There must be a reasoned basis for such a finding, based on the prior art itself, and not upon applicants’ own disclosure.

No reasoning was provided as to why one would make the proposed modification. In response to Applicants' previous response, which pointed out this deficiency, the Examiner, at page 5 of the Office Action, simply repeated the statement from the previous Office Action that “[t]herefore, it would have been obvious . . . to replace the arrangement of information writing in the control cell with the arrangement of information writing in the data cell... so that the cell can be used to write information for many nodes to utilize bandwidth of a ring more efficient[ly].”

However, this is insufficient as a motivation because it does not show where in the prior art the motivation is provided. No statement in Baudelot is referenced that would have led one to move *any* data from the data cell into the control cell, still less the data as recited in claim 1. Nor is a secondary reference identified to supply this missing feature. In effect, all the statement amounts to is that it would have been obvious to modify the prior art to meet the claim feature because then you would achieve certain advantages of the claimed feature.

As was pointed out in the previous response, the fact that the features of the applicants' invention would increase efficiency is *not* evidence that it would have been obvious to have added to the prior art the features that promotes such efficiency. On the contrary, the fact that the prior art had no teaching of a feature, combined with the fact that the feature is advantageous, is evidence of *non*-obviousness. The only motivation for making the proposed modification (which, as has been demonstrated above, does not meet all the claim features in any event), is to meet the features of the claim, which is, of course, a completely improper motivation.

The Office Action's has once again failed to provide any legally acceptable motivation to modify the reference as proposed. For at least this reason, no *prima facie* case of obviousness has been set forth. Further, rather than address Applicants' concerns regarding

the lack of a showing regarding motivation, the Examiner has simply repeated the previous deficient allegation of motivation in this Office Action. For at least this additional reason, claim 1 is believed patentable over the cited art.

Independent claims 7 and 9 recite, *inter alia*, similar features and were rejected based upon the same flawed (or absent) reasoning, and are believed patentable for at least the same reasons as claim 1.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the above, each of the claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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Respectfully submitted,

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